

REMARKS/ARGUMENTS

With this Amendment, Applicant amends claims 1 and 9. No new matter is added. For instance, support for the amendments to claims 1 and 9 may be found at least in paragraphs [0005], [0014] and [0016] of the originally-filed specification. Claims 1, 3-6 and 9-17 are all the claims currently pending in the application. However, claims 10-17 are withdrawn from consideration. Based on the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration of the application and allowance of the claims.

I. Rejection of Claims 1, 3-6 & 9 Under 35 U.S.C. § 101

Claims 1, 3-6 and 9 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Examiner alleges that claims 1 and 9 are (1) not tied to a particular machine or apparatus or (2) transform underlying subject matter. (See pg. 2 of the Office Action)

Applicant herein amends independent claims 1 and 9 to recite a specifically configured apparatus which performs steps of the recited methods. As such, independent claims 1 and 9 as herein amended are indeed tied to a machine or apparatus. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 101 rejection of independent claim 1 and its dependent claims 3-6 as well as independent claim 9.

II. Rejection of Claims 1, 3-6 & 9 Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 3-6 and 9 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In particular, the Examiner asserts that it is not clear if at least one of the prescriptions is filled and it is unclear if non-automated means that the “steps are performed without automation.” (See pg. 5 of the Office Action)

Applicant herein amends independent claims 1 and 9 and submits that these self-explanatory claim amendments overcome the § 112, second paragraph rejection. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 112, second paragraph rejection of claim 1 and its dependent claims 3-6 as well as independent claim 9.

III. Rejection of Claims 1, 3-6 & 9 Under 35 U.S.C. § 102(b)

Claims 1, 3-6 and 9 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Lasher et al. (U.S. Patent No. 5,771,657; hereinafter "Lasher").

In contrast to amended independent claim 1, Lasher does not teach or suggest and is altogether silent regarding a method of discriminating between orders comprising, *inter alia*: (A) determining a set of workstations for each prescription based on evaluating a queue of orders to determine whether one or more prescriptions within each order is fillable in *an automated manner or a non-automated manner*; and (B) wherein in response to the determination revealing that at least one of the prescriptions is fillable in an automated manner, selecting a first subset of said workstations to fill the at least one prescription *entirely automatically*, said *first subset of said workstations excludes a pharmacist review workstation for reviewing a respective filled order by a pharmacist*, as recited by independent claim 1.

In contrast to claim 1, Lasher at most discloses an automated prescription filling, sorting and packaging system that is capable of automatically dispensing prescription drugs into bottles. (Col. 4, lines 32-53). In this regard, Lasher describes that the automatic drug dispensing machines 23 dispense the tablets or capsules of the prescriptions automatically into the prescription bottles under the control of a Prescription Automation Controller (PAC) 10 as shown in FIGS. 1 and 2. Lasher also explains that the bottles that are "filled by any dispenser [are] sent to the bottle quality assurance area 109." (Col. 11, lines 60-62 & FIG. 2) Lasher also describes that the bottle quality assurance area 109 "has several **stations** at which **pharmacists** ... visually **inspect** the contents of the bottles." (Col. 12, lines 1-12) (emphasis added) In this regard, Lasher explains that the "scan of the bottle bar code [on the bottles] will bring up a display on the pharmacist's terminal which includes all the information regarding the particular prescription and order ..." (See *id.*)

In view of the foregoing, Lasher at most discloses that when the system therein fills an order automatically by dispensing prescription drugs into bottles, the system therein utilizes "several stations at which pharmacists" visually inspect the contents of prescription bottles. (Col. 12, lines 1-12) Nowhere in Lasher is there any teaching or suggestion relating to the system therein excluding the stations that the pharmacists utilize to visually inspect the prescription bottles that were automatically filled by the automatic drug dispensing machines 23.

As such, Lasher fails to teach or suggest in response to a determination revealing that at least one of the prescriptions is fillable in an *automated manner*, selecting a first subset of workstations to fill the at least one prescription *entirely automatically*, in which the *first subset of said workstations excludes a pharmacist review workstation for reviewing a respective filled order by a pharmacist*, as recited by independent claim 1. Lasher is deficient for at least this reason.

Based on at least the foregoing reasons, Applicant submits that Lasher does not teach or suggest all of the features of claim 1. Applicant therefore respectfully requests reconsideration and withdrawal of the § 102(b) rejection of independent claim 1 and its dependent claims 3-6.


Since independent claim 9 contains features that are analogous to, though not necessarily coextensive with, the features recited in independent claim 1, Applicant submits that independent claim 9 is patentable at least for reasons analogous to those submitted for claim 1.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Porter is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Cory C. Davis
Registration No. 59,932

Appl. No.: 10/772,196
Amdt. dated January 4, 2010
Reply to Office Action of October 1, 2009

Customer No. 00826

ALSTON & BIRD LLP

Bank of America Plaza

101 South Tryon Street, Suite 4000

Charlotte, NC 28280-4000

Tel Atlanta Office (404) 881-7000

Fax Atlanta Office (404) 881-7777

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON January 4, 2010.